

REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 73-153 are pending in the subject application.

Claims 73-105, 107-120, 132-135 and 153 are acknowledged as being allowable by the Examiner.

Claims 1-72 were previously canceled.

Claims 121-125, 127, 128, 136, 138 and 149 stand rejected under 35 U.S.C. §101, and/ or 35 U.S.C. §102. Claims 106, 131 and 137 were objected to because of identified informalities, but the Examiner also indicated that these claims would be allowable if the objection were overcome and if these claims were appropriately re-written in independent form. Claims 126, 129, 130, 139-148 and 150-152 were objected to as depending from a rejected base claim, however, the Examiner indicated that the claims would be allowable if appropriately re-written in independent form.

Claims 126, 136, 137 and 152 were canceled in the instant amendment without prejudice.

Claim 106 was amended as suggested by the Examiner to overcome the identified informality. Because this claim already depended from an allowed claim (*i.e.*, claim 105), Applicants did not further amend the claim so as to be in independent form as had also been suggested by the Examiner.

Claim 121 was amended to overcome the 35 U.S.C. §101 rejection. Claim 121 also was amended so as to include a limitation from allowed claim 73 concerning the securing of each end of the arcuate member to one of the adjacent vertebrae.

Claim 123 was re-written in independent form so as to include the limitations of claims 121 and 122 and was amended so as to also overcome the §101 rejection. It appears to Applicants that claim 123 was only being rejected on §101 grounds, and thus the amendment to overcome the §101 rejection places this claim in a condition for allowance.

Claim 124 was amended so as to include the limitations of objected to claim 126 and also to change “vertebrate” in line 4 to --vertebrae--. It appeared to Applicants that the objection to claim 121 on page 2 of the above-referenced Office Action should have been directed to claim 124 as the objectionable language in claim 121 did not appear in Applicants’ copy of the previously filed Response.

Claim 129 was re-written in independent form as suggested by the Examiner.

Claim 131 was re-written in independent form as suggested by the Examiner and also so as to overcome the objection raised by the Examiner.

Claim 138 was amended so this claim now depends from allowed claim 100.

The amendments to the claims are supported by the originally filed disclosure.

35 U.S.C. §101 REJECTIONS

Claims 121-123 and 149 stand rejected under 35 U.S.C. §101 as being drawing to non-statutory subject matter. More specifically the claims stand rejected because claim 121 positively recites a part of a human and thus is not considered to be patentable subject matter.

Claim 121 was amended in the foregoing amendment so the mammalian spine is not positively recited as an element of the claim. More specifically, claim 121 was amended to indicate that the arcuate member and the intravertebral prosthetic device are surgically implanted in the mammalian spine. As such withdrawal of the within rejection under §101 is respectfully requested.

Please note that in the event that the Examiner believes that the foregoing amendments to claims 121 and 123 do not overcome the §101 rejection, and that this would prevent the subject application from passing to issue then Applicants request the Examiner to contact the undersigned prior to issuance of an Advisory Action for approval to enter an Examiner's Amendment to cancel claims 121-123 and 149.

Accordingly, claims 121-123 and 149 satisfy the requirements of 35 U.S.C. §101 and , therefore, these claims are considered allowable.

35 U.S.C. §102 REJECTIONS

The Examiner rejected claims 121, 122, 124, 125, 127, 128, 136, and 138 under 35 USC §102(b) as being anticipated by Steffee [USP 4,709,303]. Applicants respectfully traverse as discussed below.

Claims 136 and 138 were canceled in the foregoing, and as such Applicants do not believe that the within rejection need be addressed further as to these claims.

As indicate above, claim 121 was amended so as to positively recite a limitation from allowed claim 73 concerning the securing of each end of the arcuate member to one of the adjacent vertebrae as well as to overcome the §101 rejection. As such, as-amended claim 121 is considered to be distinguishable from Steffe. Also, because of its dependency from claim 121, claim 122 also is considered to be in allowable form.

As indicated above, claim 124 was amended so as to include the limitations of objected to claim 126. Since claim 124 was the base claim for claim 126, Applicants respectfully submit that claim 124 is in allowable form.

As to claims 125, 127 and 128, each of these claims depends from claim 124. Thus, each of claims 125, 127 and 128 is considered to be in allowable form at least because of its dependency from a base claim that is considered to be allowable.

It is respectfully submitted that for the foregoing reasons, claims 121, 122, 124, 125, 127, and 128 are patentable over the cited reference and satisfy the requirements of 35 U.S.C. §102(b). As such, these claims, including the claims dependent therefrom are allowable.

CLAIMS 106, 131, 137

In the above-referenced Office Action, claims 106, 131 and 137 were objected to because of an identified informality. It also was provided in the above-referenced Office Action, however, that

these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s) as well as to overcome the objection.

As indicted above, claim 137 was canceled in the foregoing amendment without prejudice.

As to claims 106 and 131 each of these claims were amended as suggested by the Examiner to overcome the identified informality.

As to claim 131, this claim also was re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim there being no intervening claim(s). Accordingly, claim 131 is considered to be in allowable form.

As to claim 106, this claim was not re-written in independent form as suggested by the Examiner as this claim depends from an allowable claim (claim 105). Applicants however, reserve the right to later amend the subject application so as to present this claim in independent form or to an independent claim that contain the limitations of this claim.

CLAIMS 126, 129, 130, 139-148, 150-152

In the above-referenced Office Action, claims 126, 129, 130, 139,-148 and 150-152 were objected to as being dependent upon a rejected base claim. It also was provided in the above-referenced Office Action, however, that these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim(s).

Claim 152 was canceled in view of the foregoing amendments to the claims.

Claim 126 was not expressly re-written in independent form as suggested by the Examiner, rather claim 126 was canceled and the limitations thereof were added to the base claim, claim 124 as indicated herein. Accordingly, the base claim, claim 124, is considered to be in allowable form.

Claim 129 was were re-written in the foregoing amendment so as to be in independent form and to include all the limitations of the base claim there being no intervening claim(s). Accordingly, claim 129 is considered to be in allowable form.

As to claim 130, this claim was not re-written in independent form as suggested by the Examiner as it depends from claim 129. Applicants however, reserve the right to later amend the subject application so as to present this claim in independent form or to an independent claim that contains the limitations of this claim.

As Applicants believe that the base claim, claim 78, is in allowable form, claims 139 and 140 were not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 139 and 140.

As Applicants believe that the base claim, claim 88, is in allowable form, claims 141 and 142 were not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 141 and 142.

As Applicants believe that the base claim, claim 95, is in allowable form, claims 143 and 144 were not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 143 and 144.

As Applicants believe that the base claim, claim 102, is in allowable form, claims 145 and 146 were not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 145 and 146.

As Applicants believe that the base claim, claim 110, is in allowable form, claims 147 and 148 were not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present any one or more of these claims in independent form or to add one or more independent claims that contain the limitations of any one or more of claims 147 and 148.

As to claim 150, this claim depends from claim 131, which claim as indicated herein was re-written in independent form as suggested by the Examiner so as to be put into allowable form. Thus, as Applicants believe that the base claim, claim 131 is in allowable form, claim 150 was not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present this claim in independent form or to an independent claim that contains the limitations of claim 150.

Applicant: Allen Carl, et al.
U.S.S.N. : 10/019,265
Response to Final Office Action
Page 26 of 26


As Applicants believe that the base claim, claim 135, is in allowable form, claim 151 was not re-written in independent form as suggested by the Examiner. Applicants, however, reserve the right to later amend the subject application so as to present this claim or to add an independent claim that contains the limitations of claim 151.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Because the total number of claims and/or the total number of independent claims post amendment now exceed the highest number previously paid for, a check is enclosed herewith for the required additional fees. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

Date: September 24, 2004

By: 
William J. Daley, Jr.
(Reg. No. 35,487)
P.O. Box 55874
Boston, MA 02205
(617) 439- 4444

Customer No. 21,874